

REMARKS

1. In response to the Office Action mailed February 13, 2006, Applicant respectfully requests reconsideration. Claims 1-26 were originally presented in the application. In the outstanding Office Action, claims 1-7, 10-17 and 20-26 have been rejected while claims 8, 9, 18 and 19 have been objected to. By the foregoing Amendments, claims 1, 2, 4, 5, 7-9, 11, 12, 14-16, 20-24, and 26 have been amended. No claims are canceled. Claims 27-30 have been added. Thus, upon entry of this paper, claims 1-30 will remain pending in this application. Of these thirty (30) claims, three (3) claims (claims 1, 11 and 20) are independent. Based on the above Amendments and following Remarks, Applicant respectfully requests that all outstanding objections and rejections be reconsidered, and that they be withdrawn.

2. Support for the amendments to claim 1 is found in originally filed claims 7, as well as elsewhere through the specification, drawings, and originally filed claims. Support for the amendments to claim 11 is found in originally filed claims 17, as well as elsewhere through the specification, drawings, and originally filed claims. Support for the amendments to claim 20 is found in originally filed claims 26, as well as elsewhere through the specification, drawings, and originally filed claims. Support for new claims 27-29 is found in paragraphs 17-23 on pages 4-6 of the specification, as well as elsewhere through the specification, drawings, and originally filed claims.

Amendments to the Specification

3. The amendments to the specification are to address minor typographical errors and do not add new matter.

Acceptance of Drawings

4. Applicant acknowledges the Examiner's indication that the drawings filed on April 22, 2004 are deemed acceptable.

Art of Record

5. Applicant acknowledges receipt of form PTO-892 identifying additional references made of record by the Examiner.

6. Applicant thanks the Examiner for returning the form PTO-1449 filed by Applicant on April 22, 2004, which has been initialed by the Examiner indicating consideration of the references cited therein.

Allowed Claims

7. Applicant notes with appreciation the Examiner's indication that claims 9, 10, 18 and 19 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Rejection of Claims 1 and 11 under 35 U.S.C. § 103(a) as being unpatentable over Intel

8. Independent claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Intel Corporation, "Accelerated Graphics Port Interface Specification," May 4, 1998; Revision 2.0 (hereinafter, "Intel"). Independent claim 1, as amended, incorporates features from claim 7, namely a "voltage doubling circuit configured to double the power signal." Claim 7 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Intel in view of USBIF. For at least the reasons set out below, this rejection is not applicable to independent claim 1 as amended herein.

9. Independent claim 11 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Intel. Independent claim 11, as amended, incorporates features from claim 17, namely a "voltage doubling circuit configured to double the power signal." Claim 17 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Intel in view of USBIF. For at least the reasons set out below, this rejection is not applicable to Independent claim 11 as amended herein.

10. In addition, independent claim 20 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Intel in view of USBIF. Independent claim 20, as amended, incorporates features from claim 26, namely a "voltage doubling circuit configured to double the power signal." Claim 26 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Intel in view of USBIF. For at least the reasons set out below, this rejection is not applicable to Independent claim 20 as amended herein.

11. Independent claim 1, as amended, claims, *inter alia* "an expansion card for adding to a computer system a Universal Serial Bus (USB) port, comprising: ... ***a voltage doubling***

circuit configured to double the power signal.” (See Applicants claim 1, above; emphasis added.). Independent claim 11, as amended, claims, *inter alia* “an expansion card comprising: ... *a second circuitry for doubling the voltage of the power signal.....*” (See Applicants claim 11, above; emphasis added.). Independent claim 20, as amended, claims, “an expansion card comprising: ... *a doubling circuit for doubling the power signal... .*” (See Applicants claim 20, above; emphasis added.)

12. In rejecting claims 7, 17 and 26 (now incorporated as a feature in independent claims 1, 11 and 20, respectively), the Examiner failed to articulate a suggestion or motivation to combine the references and thus failed to establish a *prima facie* case of obviousness as required under MPEP Sections 706.02(j) & 2143. (See, *In re Rouffet*, 149 F.3d 1350, 1357 (Fed. Cir. 1998) (“To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness.”)). Sufficient evidential support for the motivation to combine must be shown in the prior art suggesting a combination of references. (See, *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002); see also, *In re Kotzab*, 217 F.3d 1365, 1371 (Fed. Cir. 2000) (“[P]articular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed.”)).

13. The only statement regarding the motivation to combine Intel with USBIF is a conclusory statement that “it would have been obvious to one of ordinary skill in this art at the time of the invention by applicant to utilize a voltage-doubling circuit in the expansion card of Intel Corporation and USBIF for the purpose of providing the 24VDC in a USB port as required by the USB-Plus-Power Specification.” (See, Office Action, pages 5, 11 and 18.) The Office Action fails to cite any passage of Intel that would motivate one of ordinary skill in the art to combine the teachings of Intel with USBIF. Moreover the Office Action admits that USBIF and, thus the combination of Intel with USBIF, “fail to explicitly teach a circuit configured to convert the 12VDC power signal to a 24VDC.” (See, Office Action, pages 5.). This admission by the Examiner reflects that Intel and USBIF each fail to teach every claim element nor provide a motivation to combine the references as proposed by the Examiner. Instead, the Examiner takes official notice that “voltage-doubling circuits are old, and well known in this art.” (See, Office Action, pages 5, 11 and 18; hereinafter “Official Notice.”) However, the Examiner fails to supply any motivation to combine Intel with USBIF and the

14. A mere assertion that it would have been obvious to combine references is not a substitute for the absence of objective, well-reasoned findings to support a motivation to combine. Because the Examiner has not provided adequate motivation to combine Intel with USBIF and the allegedly well-known voltage doubling circuit, it can be reasonably assumed the Examiner selected the references with the assistance of impermissible hindsight. (*See, In re Rouffet*, 149 F.3d 1350, 1358 (Fed. Cir. 1998).). The Federal Circuit has repeatedly stated that the use of hindsight must be guarded against by having the Examiner provide sufficient evidence to support the motivation. (*See, e.g., In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998); *In re Dembiczak*, 175 F.3d 994 (Fed. Cir. 1999).). Therefore, without proper objective evidence the Office Action fails to establish a proper *prima facie* case of obviousness, and thus the rejections of claims 1, 11 and 20, are improper and should be withdrawn.

15. Furthermore, should the Examiner continue to rely on facts outside the record of this application to support the obviousness rejections of claims 1, 11 and 20, Applicant respectfully requests that the Examiner provide an affidavit to support the Examiner's assertion that "voltage-doubling circuits are old, and well known in this art," as well as to support the Examiner's assertions regarding motivation to combine the references. (*See*, 37 C.F.R. § 1.104(d)(2).)

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Dependent Claims

17. The dependent claims incorporate all of the subject matter of their respective independent claims and add additional subject matter which makes them *a fortiori* independently patentable over the art of record. Accordingly, Applicant respectfully requests that the outstanding rejections of the dependent claims be reconsidered and withdrawn.

Conclusion

18. In view of the foregoing, this application should be in condition for allowance. A notice to this effect is respectfully requested.

Respectfully submitted,

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